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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,501	09/09/2003	Albert James Yovichin	DN2003145	1802

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EXAMINER

KNABLE, GEOFFREY L

ART UNIT PAPER NUMBER

1733

DATE MAILED: 09/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/658,501

Applicant(s)

YOVICHIN ET AL.

Examiner

Geoffrey L. Knable

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
4a) Of the above claim(s) 1-8 and 12-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 9-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/9/03;7/28/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-6, drawn to a method of building and transferring a tread belt, classified in class 156, subclass 111.
 - II. Claim 7, drawn to a method of forming a spirally wound belt layer, classified in class 156, subclass 117.
 - III. Claim 8, drawn to a method of removing a tread belt from a drum, classified in class 29.
 - IV. Claims 9-11, drawn to an apparatus to build a tread belt assembly, classified in class 156, subclass 110.1.
 - V. Claims 12-16, drawn to an apparatus for building and transferring a tread belt, classified in class 156, subclass 396.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as in a process in which there is no spirally wound layer and invention II has separate utility such as in a process of building a tire in which the tread belt remains about a horizontal axis, i.e. with no pivoting. See MPEP § 806.05(d).
3. Inventions I and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2)

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that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the omission of details of the claimed subcombination in the claims to the combination provides evidence that the patentability of the combination does not rely on the details of the specific subcombination. The subcombination has separate utility such as in a process in which there is no transfer to a pivoting transfer device, removal being from the drum on its shaft.

4. Inventions I and V are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus can be used to practice another materially different process such as building an annular drive belt or building only a tread (i.e. no belt).

5. Inventions V and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the omission of details of the claimed subcombination (weight sensor, etc.) in the combination is evidence that the

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patentability of the combination does not rely on the details of the specific subcombination. The subcombination has separate utility such as in any building means for building a tire including those that do not include a pivoting transfer means.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. During a telephone conversation with June Rickey on September 8, 2005 a provisional election was made with traverse to prosecute the invention of group IV, claims 9-11. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-8 and 12-16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

9. Claims 9-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The preamble of claim 9 refers to an "apparatus for building and transferring a tread belt reinforcing assembly" whereas the body of claim 9 only describes a building drum with rotating drive means with a weight sensor attached to the shaft. It therefore

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is not entirely clear that the scope of protection afforded by this claim can be readily ascertained - in other words, it is not clear if this claim is limited to a rotating building drum with a weight sensor or also includes sufficient structure to build/transfer a tread belt. Clarification is required - if it is the latter, it would be clearer if for example the claim were recast in Jepson form (In an apparatus..., the improvement comprising...).

In claim 9, line 5, reference is made to "a building drum" but there is no indication of whether this is the same drum as defined in line 3. As it is apparently the same drum, it would be clearer if this were reflected in the claim (e.g. "a building drum" to "the building drum", it perhaps being more logical to define "a building drum" first in the claim, i.e. before the drive means).

In claim 10, no literal antecedent has been established for "the weight sensor data".

In claim 11, no antecedent has been established for "the computer control means", it being noted that claim 10 only defines a computer controlled means."

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Jackson et al. (US 4,341,119).

Jackson et al. discloses an apparatus including a drive means (16) for rotating a tire support, this drive including a drum-supporting shaft 12/13. Further, a weight

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sensor is used to measure the weight of the drum assembly - note esp. col. 2, line 58 - col. 3, line 18. Although this reference is not directed to building and transferring a tread belt, it is not considered that at present this claim clearly and unambiguously defines structure that would define over the teachings of this reference. In other words, claim 10 at present seems to only require a drum/drive/shaft and weight sensors connected to the shaft, it being considered that the tire or tire support reads on the claimed drum.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wulker et al. (US 5,942,059) and Hine (US 3,716,442) disclose building at least a tread by winding on a drum where the winding process is controlled based upon the buildup on the drum. These patents do not however suggest a weight sensor connected to a drum shaft to effect this control.

Moon (US 4,233,255) and Rhee (US 4,647,328 - note esp. weigh station 18 in fig. 6) each disclose tread extrusion in which the weight of the extrusion is measured. A weight sensor connected to a drum supporting shaft is not however suggested.


Girard (US 3,785,582) discloses weighing yarn during winding but the weight is measured by weighing the yarn source rather than the wound bundle and this reference is also not directed to an apparatus for building and transferring a tread belt.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 571-272-1220. The examiner can normally be reached on M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on 571-272-1171. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Geoffrey L. Knable
Primary Examiner
Art Unit 1733

G. Knable
September 13, 2005